

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

J&J Docket No. **DEP5213USNP**

MMB Docket No. **1671-0285**

Confirmation No.: **2398**

Application of: **Ondrla et al.**

Group Art Unit: **3774**

Serial No. **10/748,448**

Examiner: **Javier G. Blanco**

Filed: **December 30, 2003**

For: **Joint Prosthesis with Infinitely Positionable Head**

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REPLY BRIEF

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Sir:

This is a reply submitted in response to the Examiner's Answer dated August 15,
2008 (hereinafter the "Answer").

Discussion

The Answer includes a number of new arguments and, for the first time, presents an interpretation of a document cited by the Examiner. While the discussion set forth in the Appellant's Amended Appeal brief clearly and correctly identifies the relevance of the prior art cited by the Examiner as applied to the Appellants' claims, with the exception of the discussion of claim 34 which is modified below, the errors in the Examiner's newly formed arguments and the newly presented interpretation of prior art further exhibit the patentability of the Appellants' claims.

1. Claim 34

The Examiner correctly identified an error in the Appellants' arguments regarding the patentability of claim 34 over Horber and Glien. (Answer at pages 9 and 11). Accordingly, the Appellants withdraw the argument presented in the Appeal Brief at pages 12 and 17, directed to claim 34, and request the following corrected arguments be considered.

Discussion re: Patentability of Claim 34 over Horber

Claim 34 depends from claim 32 and recites that the "internal bore comprises a tapered portion" and that the "perimeter of the bore is defined by the intersection of the plane with the tapered portion of the bore." This element modifies claim 32 to require the spherical articulating portion to touch the internal bore around substantially an entire perimeter of a tapered portion. For purposes of this Appeal Brief, this is the same limitation discussed with reference to the patentability of claim 27 over Horber.

Accordingly, in addition to the reasons set forth with respect to claim 32 in paragraph 3 below, claim 34 is patentable over the prior art because Horber fails to disclose a spherical articulating portion contacting a tapered portion of an internal bore within the mounting element and the Board of Appeals is respectfully requested to overturn the rejection of claim 34.

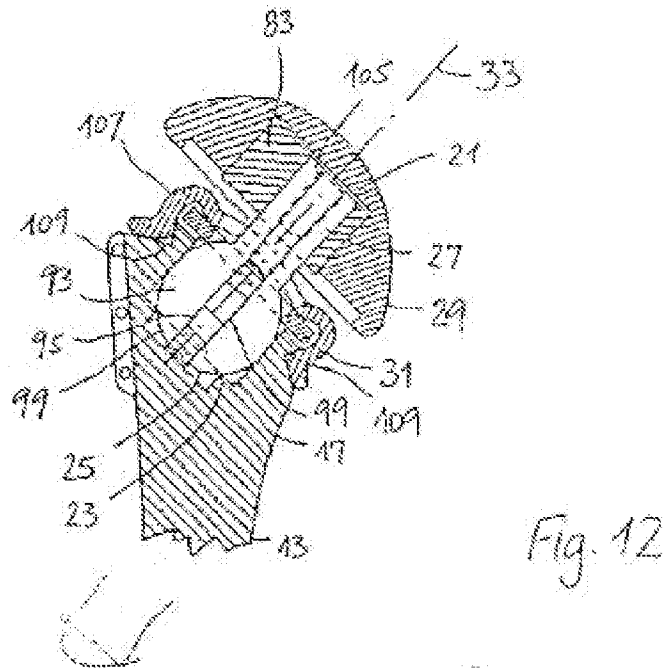
Discussion re: Patentability of Claim 34 over Glien

Claim 34 depends from claim 32. Accordingly, for at least the reasons set forth with respect to claim 32, claim 34 is patentable over the prior art and the Board of Appeals is respectfully requested to overturn the rejection of claim 34.

2. Horber's Figure 12 Has Been Mischaracterized

The Examiner now argues, with respect to claims 28 and 32, that the fastener 105 and FIG. 8 of Horber disclose a fastener as recited in the claims. (Answer at pages 8-9). The Examiner's characterization of Horber is directly contradicted by the teaching of Horber.

The Examiner alleges "[t]he distal part of fastener 105 is clearly shown in Figure 12 as contacting the stem." (Answer at page 9). Figure 12 of Horber (set forth below) while perhaps acceptable for showing the device of Horber, cannot reasonably be relied upon for disclosing features not otherwise described in Horber.

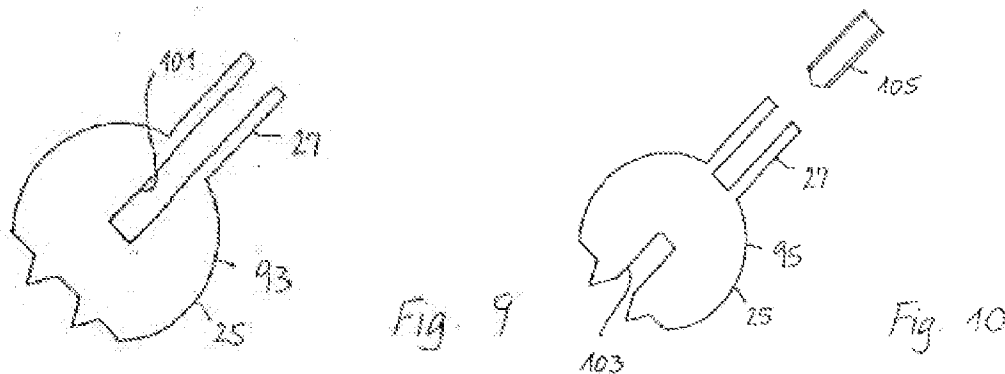


The Examiner has opined, apparently based solely upon a visual inspection, that the fastener 105 extends from the top right of the collar extension 27 to a location in contact with the shaft 13, apparently at a location proximate to the lower left terminus of axis 33. The area between those two locations, however, includes a rather confusing array of dashed and solid lines. Therefore, based solely on a visual inspection, Figure 12 cannot reasonably be said to “clearly” show any specific outline of the fastener 105.

Moreover, the description, which the Appellants submit is required to be consulted in order to understand the structure of FIG. 12, unequivocally describes the structure of FIG. 12 in a manner which eliminates any possibility of the fastener 105 contacting the stem.

Specifically, at column 9, lines 33-35, Horber states “FIG. 12 shows a tenth exemplified embodiment in which the collar piece 21 is made up of two parts 93, 95. Except for the shape of the joint head 25, the collar piece 21 corresponds exactly to the

collar piece 21 shown in FIGS. 9 to 11.” FIGs. 9 and 10 of Horber, set forth below, clearly show that when the slot 103 is inserted into the slot 101 as described at column 9, lines 12-15, the resulting “groove” formed by the collar extension 27 of parts 93 and 95, into which the fastener 105 is inserted, terminates at the top of the part 95. (Horber at column 9, lines 15-17)



Additionally, the size of the fastener 105 shown in FIG. 10, corresponds to the length of the slot defined by the collar extension 27 of part 95. This further indicates that the fastener 105 does not penetrate the bottom of the slot formed by the collar extension 27.

Therefore, because Horber describes the collar piece 21 of FIG. 12 in a manner which makes it physically impossible for the fastener 105 to extend through the part 95 so as to contact the stem, the Examiner’s reliance on blurry details in FIG. 12 to support an allegation that the fastener 105 extends through the part 95 so as to contact the stem 13, is unreasonable. Accordingly, as discussed in the Appeal Brief, the Appellants’ claims are patentable over Horber.

3. Horber's Figure 8 Has Been Mischaracterized

The Examiner newly alleges that FIG. 8 of Horber discloses the limitations of claims 28 and 32. (Answer at pages 8-9). The Examiner has mischaracterized the teaching of Horber.

Discussion re: Claim 28

Specifically, the invention of claim 28 depends from claim 27 and requires “an interior wall portion located within the first coupler bore that extends inwardly toward a longitudinal axis of the first coupler bore from the proximal surface in a straight line.” FIG. 8 of Horber discloses a “hollow spherical surface.” (Horber at column 8, lines 41-43). A “spherical” surface is not a “straight line”. Therefore, Horber does not disclose the use of a fastener that contacts the stem in a cavity with a straight line as recited in claim 28.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Horber does not disclose each element of the Appellants' claim 28, for any or all of the foregoing reasons, as well as the reasons set forth in the Appeal Brief, Horber does not anticipate Appellants' claim 28. Accordingly, the Board of Appeals is respectfully requested to overturn the rejection of claim 28.

Discussion re: Claim 32

Claim 32 recites a screw that is “coupled with the spherical articulating portion of the mounting element.” The collar piece 21 of FIG. 8, however, “is of cylindrical

construction.” (Horber at column 8, lines 38-41). A cylinder is not a sphere. Therefore, Horber does not disclose a screw that is coupled with a spherical articulating portion of a mounting element. Appellants note that Horber does refer to “a virtual spherical surface.” (Horber at column 8, line 41). The discussion, however, merely identifies the position of two ridges, identified as “circuit edges 23, 23’”. These ridges are pressed into the spherical surface of cavity 19 using a screw 91 to “prevent any pivoting of the collar piece 21.” (Horber at column 8, lines 50-54). Accordingly, because Horber does not disclose a screw that is coupled with a spherical articulating portion of a mounting element, FIG. 8 of Horber does not anticipate claim 32.

Additionally, as discussed in the Appeal Brief at pages 18-19, claim 32 requires structure that provides a “press-fit”. As discussed by Horber at column 8, lines 50-54, the embodiment of FIG. 8 is not press-fit.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Horber does not disclose each element of the Appellants’ claim 32, for any or all of the foregoing reasons, Horber does not anticipate Appellants’ claim 32. Accordingly, the Board of Appeals is respectfully requested to overturn the rejection of claim 32.

4. Glien and the Claims are Mischaracterized/Misconstrued

In the Answer, the Examiner argues that his characterization of Glien is correct based upon a construction of “point” and “a coupler opening.” Neither argument is persuasive.

The Examiner first argues that “at a point” “could be broadly interpreted as one end of the straight line, which is clearly shown as being touched by the spherical articulating portion in Figures 4, 5, 9, and 10. (Answer at page 10). The newly provided interpretation of Glien describes the device of FIGs. 4, 5, 9, and 10 in a manner which specifically contradicts the Examiner’s argument.

Specifically, the Examiner appears to argue that device of Glien is clamped at the point formed by two intersecting surfaces (seen as lines in cross section), and that the intersection of the two lines constitutes the end point of both lines/surfaces. Glien at page 10, paragraph 46 (reference to the interpretation provided), specifically states “a clamping element 30 is inserted, which clamping element clamps the segments 27 of projection 23 against the clamping surfaces 16, 17 of recess 14 on the proximal end of stem 10 (Figure 4).” Glien thus states that the contact occurs on opposing faces of the surfaces, not at the points formed by those surfaces with other surfaces. Therefore, because the Examiner’s proposed understanding of the figures of Glien is specifically contradicted by the written description of the figures provided by Glien, the Examiner has mischaracterized Glien.

The Examiner next argues that a proximal surface defining a coupler opening “could be broadly interpreted as the proximal/basal 1/3 of cavity 14.” The Examiner thus proposes a construction of the claim such that an internal surface of a coupler could be used to define “a coupler opening.” It is well established that the words of a claim must be given their plain meaning unless an applicant has provided a clear alternate definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). A “surface that defines a coupler opening” plainly means an interruption in a proximal surface through which entry into the coupler is obtained. Nothing in the

specification changes that meaning. Nothing in the specification redefines the plain meaning to include “an internal portion of a coupler which defines another internal portion of the coupler.” Therefore, there is no reasonable basis for the Examiner’s newly contrived construction. Therefore, because the internal surfaces of the coupler cannot be a proximal surface defining an opening to the coupler, the Examiner has mischaracterized Glien.

Accordingly, for the reasons set forth above, as well as those set forth in the Appeal Brief, claim 27 is patentable over Glien.

7. Examiner’s New Evidence Provides Additional Proof of Patentability

Additionally, the newly provided interpretation of Glien identifies the features shown in FIG. 1 as reference numbers 26 as “slots.” (Glien at page 13 and FIG. 1). As stated at paragraph 45 on page 10 of Glien, “[t]he entire length of projection 23 is segmented by two intersecting slots 26.” Accordingly, contact between the projection 23 and the clamping surfaces 16,17 is interrupted by two slots. Claim 32, however, recites “that the spherical articulating portion touches the internal bore around substantially an entire perimeter of the bore.” A body with two slots as depicted in Glien at FIG. 1 cannot contact the clamping surfaces 16,17 around substantially an entire perimeter of the clamping surfaces 16,17.

Therefore, for this additional reason, newly available from the newly provided interpretation of Glien, as well as the reasons set forth in the Appeal Brief, claims 32-37 are patentable over Glien.

6. Remaining Arguments

Finally, the discussion set forth in the Appeal Brief with respect to the patentability of the claims over the cited art adequately refute the other newly proposed rationales set forth in the Answer.

Conclusion

For the reasons set forth above and for all of the reasons set forth in the Appellants' Appeal Brief, claims 27-35 are not anticipated by Horber, claims 27 and 29-37 are not anticipated by Glien, and claims 32-33 are not anticipated by Leonard. Accordingly, the Board of Appeals is respectfully requested to reverse the rejections of claims 27-37.

Respectfully submitted,

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